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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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THOMSON LICENSING INC. PATENT OPERATIONS PO BOX 5312 PRINCETON, NJ 08543-5312			VU, NGOC K	
			ART UNIT	PAPER NUMBER
			2611	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/582,371

Applicant(s)

WESTLAKE ET AL.

Examiner

Ngoc K. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9-13 and 17 is/are rejected.
- 7) ☒ Claim(s) 6-8 and 14-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/14/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments filed 2/14/05 have been fully considered but they are not persuasive.

With respect to claim 1, applicant argues that Boyer does not disclose or suggest the step of comparing terms in an electronic message to terms in program information of an EPG. This argument is not persuasive.

Boyer's system as shown in figure 1 comprises a receiver, i.e., set top box 50 in multimedia system 30, for receiving television signals including program guide information. Next, display 218, as shown in figure 2, comprises new reminders box 231 to allow the user ordering an email reminder messages. If the box 231 is selected, the user is presented with new reminders page 810 of figure 8. Thus, it must be understood that the user receives the email reminders page or reminders message 810 via the receiver, i.e., set top box 50. Boyer further discloses that if the user initially does not enter the exact title of the television program in new reminders page 810, the data of program listings 220 or nay other suitable set of television program listings data may be scanned to find the program or programs that most closely match the program title entered by the user. From this point, the receiver must perform operation for comparing the entered term(s) in the reminders message 810 to term(s) in the programming listings 220 of the EPG to find the program(s) that most closely match the title entered by the user. If several matches are found, a list of the program matches is presented to user so that the user may select a desired program from the list (see 0055-0056 and figures 2 and 8). In another words, this displayed list comprises both matched term(s) and not matched term(s) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

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combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

of the program title(s) in view of the user's selection since the user chooses only a desired program title from the list. That is, the user distinguishes the desired program title from the other program titles in the list so that the desired program title is finally entered in box 818 in the reminders message 810. Thus, Boyer teaches displaying in the reminders message 810 a list of titles so that term(s) in the reminders message which have a match in the program information 220 (i.e., a desired program title is selected by the user from the list) based on the comparing terms step, are distinguishable from terms which have no such match (i.e., the other program titles in the list are not selected by the user).

Applicant further argues that even if a user enters an exact term and the system only displays that term, the system still does not displays terms that are not matched because there is either no unmatched term in the case the user entering an exact program title, or the term not matched is replaced by other terms in the case that the user does not enter an exact program title as discussed. Examiner respectfully disagrees. It is noted that the claim does not exclude such feature.

With respect to claim 2, applicant argues that Boyer does not teach or suggest the step of establishing an electronic link between at least one term in the electronic message and any program information which has match for the at least one term. Applicant further compares the feature "an electronic link" as highlighting illustrated in FIG. 4 and FIG. 5 of the present application with the teaching of Boyer. These arguments are not persuasive. First, the above features as addressed by the applicant are not claimed. Second, the limitation recited in claim 2 still reads on the teaching of Boyer. In connection with the above interpretation, a desired program title is automatically updated for displaying in box 818 of the reminders message 810

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when the user selects the desired program title from the list (see 0056). That is, the receiver establishes an electronic link (i.e., attached a program title selected from the list in box 818) between the term(s) in the reminders message 810 and program listings 220 which has a match for the term(s).

With respect to claim 3, applicant disagrees that selecting the program title in the new reminders page 810 effects any implementation in teaching of Boyer. In response, Boyer's teaching comprises the selection of the desired program title with a match by the user effects implementation of a desired program which is defined by the program information 220 having the match so that the system later generates a message to remind the user about broadcasting of the desired program (see figure 12).

In response to applicant's arguments, with respect to claims 5 and 13, against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Therefore, rejection for claims 1-5, 9-13 and 17 are maintained based on the supportive reasons above.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 1-4, 9-12 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Boyer et al. (U.S. 200200264996 A1).

Regarding **claim 1**, Boyer discloses a method of linking terms (titles) in an electronic message (reminder) to program information in an EPG, the method comprising the steps of:

receiving an electronic message (reminder 810 – see figure 2);

comparing terms in the electronic message to terms in the program information of the EPG (for example, if the user does not enter the exact title(s) of the television programs in reminder screen 810, the data of program listings 220 or any other suitable set of television program listings data may be scanned to find the programs that most closely match the program title(s) indicated by the user. That is, the receiver 50 compares the title(s) entered by the user in the reminder to the titles in the program listings data 220 in EPG - see page 4, 0056 and figures 1-2);

displaying the electronic message so that any terms in the electronic message which have a match in the program information based on the step of comparing terms, are distinguishable from terms which have no such match (displaying in the reminder a list of titles that most closely matches based on the step of comparing titles, the user may choose the actual title(s) or the closest matched title(s). That is, the list of title including the title(s) have a match are distinguishable from the title(s) which have no match by the user – see page 4, 0056).

Regarding **claim 2**, Boyer discloses establishing e-mail reminder message including reminding the broadcast of the selected title(s) or the closest matched title(s) (see figure 8 and page 4, 0055).

Regarding **claim 3**, Boyer discloses establishing e-mail reminder message is performed so that selection of the title(s) with a match by the user (e.g., the actual title(s) or the closest

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matched title(s) selected by the user) effects implementation of a respective program which is defined by the program information having the match (e.g., reminding the broadcast of the program having the actual title(s) or the closest matched title(s) – see figure 12 and page 4, 0055).

Regarding **claim 4**, Boyer shows displaying an electronically generated menu of choices (e.g., 830 and 824 – in figure 8) in response to user selection of the closest matched title(s), each of the choices being selected by the user to effect an action described by each choice (for example, if the user selects the “1 hour” option in choice 830 and the “each time this week” option in choice 824, the user will receives five e-mail reminder messages 1 hour before each broadcast of the program during that week (see figure 8; page 4, 0058 and pages 3-4, 0048 and 0049).

Regarding **claim 9**, Boyer discloses a electronic message interface adapted to link terms (titles) in an electronic message (reminder) to program information in an EPG, the electronic message interface comprising:

a receiver adapted to receive an electronic message (e.g., user receives reminders message 810 via receiver 50 – see figures 1-2);

comparison unit (within receiver 50) adapted to compare terms in the electronic message to terms in the program information of the EPG (for example, if the user does not enter the exact title(s) of the television programs in reminder screen 810, the data of program listings 220 or any other suitable set of television program listings data may be scanned to find the programs that most closely match the program title(s) indicated by the user. That is, the receiver 50 compares the title(s) entered by the user in the reminder to the titles in the program listings data 220 in EPG - see page 4, 0056 and figures 1-2);

a display device (54) adapted to display the electronic message so that any terms in the electronic message which have a match in the program information based on the step of comparing terms, are distinguishable from terms which have no such match (displaying in the reminder a list of titles that most closely matches based on the step of comparing titles, the user may choose the actual title(s) or the closest matched title(s). That is, the list of title including the title(s) have a match are distinguishable from the title(s) which have no match by the user – see page 4, 0056 and figure 1).

Regarding **claim 10**, Boyer discloses establishing e-mail reminder message including reminding the broadcast of the selected title(s) or the closest matched title(s) (see figure 8 and page 4, 0055).

Regarding **claim 11**, Boyer discloses a selector (within receiver 50) adapted to select the actual title(s) or the closet matched title(s) selected by the user, via the e-mail reminder message, implementation of a respective program which is defined by the program information having the match (e.g., reminding the broadcast of the program having the actual title(s) or closest matched title(s) – see figure 12 and page 4, 0055).

Regarding **claim 12**, Boyer shows displaying on the display device (54) an electronically generated menu of choices (e.g., 830 and 824 – in figure 8) in response to user selection of the closest matched title(s), each of the choices being selected by the user to effect an action described by each choice (for example, if the user selects the “1 hour” option in choice 830 and the “each time this week” option in choice 824, the user will receives five e-mail reminder messages 1 hour before each broadcast of the program during that week (see figures 1 and 8; page 4, 0058 and pages 3-4, 0048 and 0049).

Regarding **claim 17**, Boyer shows that the display device is a television (see figure 1).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyer et al. (U.S. 200200264996 A1) in view of Hirata (US 6,374,406 B2).

Regarding **claims 5 and 15**, Boyer teaches sending email reminder message to remind the broadcast of the selected program(s) by the user. The email reminder message shows the program information of the selected program(s) (see abstract and figure 12). Boyer does not teach the email reminder message including the feature of recording the program. However, Hirata teaches that an email message comprises a control command, for example, "video reservation" in Subject of the email message. This suggests that the email includes a control command to reserve a recording of a program or channel (see col. 5, lines 42-50 and figure 3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the email reminder message of Boyer by including recording command in the email message to reserve a recording of a program or channel as taught by Hirata in order remotely control recording the selected program or channel via email with less operation cost.

Allowable Subject Matter

6. Claims 6-8 and 14-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 703-306-5976. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ngoc K. Vu
Primary Examiner
Art Unit 2611

July 11, 2005